

REMARKS

In the Reply, Applicant proposes to amend claims 38, 48, and 51, cancel claims 42, 46, and 52-56, and add new claims 58-66. No new matter will be added. Accordingly, claims 38-41, 43-45, 47-51, and 57-66 will be pending. Applicant requests re-examination and prompt allowance of this application.

In the Office Action dated March 27, 2008 (the "Office Action"), the Examiner noted "that Applicant has claimed statements of intended use and other functional statements, i.e., how the ends of the plurality of wire [sic] release from each other when a predetermined force is applied to the basket." Office Action at pages 2-3. The Office Action then states that "[s]uch functional limitations fail to further structurally distinguish the present invention from the prior art." Office Action at page 3. Applicant respectfully traverses this assertion.

There is nothing inherently wrong with defining some part of an invention in functional terms. M.P.E.P. § 2173.05(g). Structural limitations define the structure of an element by what it is, and *functional* limitations define the structure of an element by what it does, but both structural and functional limitations define the structure of an element. See M.P.E.P. §§ 2114, 2173.05(g). Functional limitations "*must be evaluated and considered, just like any other limitation of the claim.*" M.P.E.P. § 2173.05(g) (emphasis added). Accordingly, the Office Action's position is incorrect, and Applicant respectfully requests that the Examiner evaluate and consider the wholly appropriate functional limitations within the claims. Nonetheless, to expedite prosecution, Applicant has elected to amend claim 38 herein.

Anticipation Rejections

In the Office Action, claims 38-40, 42, 44, 47-52, and 54-55 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Pat. No. 6,872,211 to White et al. ("White"). Applicant respectfully traverses this rejection. A proper anticipation rejection requires each and every element set forth in the claim to be found in a single prior art reference. M.P.E.P. § 2131. The rejection set forth in the Office Action does not properly establish that each and every claimed element of the claims is disclosed in White.

Amended claim 38 requires, *inter alia*, a "plurality of wires [that] are joined at a joint configured to fail when a first predetermined force is applied to the joint, the distal ends of the plurality of wires releasing from each other when the joint fails, [wherein] the first predetermined force [is] less than a force required to cause one of the plurality of wires or the proximal end of [a] basket to fail." The Office Action relies on col. 12, lines 64-67 of White to disclose basket 15 failing when a predetermined force applied to the basket 15 is less than a force required to cause one of the plurality of wires 21 or the proximal end of the basket 15 to fail. Office Action at page 2. White, however, discloses on col. 12, lines 64-67, a guidewire 41 that causes retrieval assembly 15 to invert. See also White at Figs. 22A and 22B. White does not disclose or even suggest, on col. 12, lines 64-67 or elsewhere, that the distal ends of wires 21 release from a joint upon an application of a force on basket 15 that is less than a force required to cause one of wires 21 or the proximal end of basket 15 to fail. The Office Action also relies on Figures 7A and 8B of White to show that the plurality of wires 21 are capable of being released from each other when a certain force is applied to the basket since the

connecting joint member 27 has an opening at its proximal end that allows for the basket portions 28 to become detached from wires 21. Office Action at page 3. White, however, does not disclose or even suggest, in Figures 7A, 8B, or in the description of those figures, the relative force required to detach basket portions 28 from wires 21 with respect to the relative force required to cause one of wires 21 to fail. Accordingly, Applicant submits that claim 38 is allowable for at least these reasons. Additionally, pending claims 39, 40, 44, and 47-51 depend from claim 38 and are allowable for at least these reasons as well as for their additional features. Claims 42, 52, 54, and 55 are cancelled herein and the rejection thereof is rendered moot.

Obviousness Rejections

In the Office Action, claims 43, 45, 46, 53, and 56 were rejected under 35 U.S.C. § 103(a) as unpatentable over White, and claim 41 was rejected as unpatentable over White in view of U.S. Pat. No. 5,944,728 to Bates et al. ("Bates"). A proper *prima facie* case of obviousness requires, *inter alia*, that all claim features must be considered when judging the patentability of a claim against the prior art. M.P.E.P. § 2143.03. The rejections set forth in the Office Action fail to consider all of the claimed elements set forth in the claims, as amended herein.

Claims 46, 53, and 56 are cancelled herein and the rejection thereof is rendered moot. Claims 41, 43, and 45 depend directly or indirectly from independent claim 38 and are therefore allowable for at least the reasons set forth above. In addition, each of these dependent claims recites unique combinations that are neither taught nor suggested by the cited art, and therefore each is also separately patentable.

New Claims

Claim 58 depends from independent claim 38 and is allowable for at least the reasons set forth with respect to claim 38 as well as for its additional features. Claims 59 and 64 are allowable for reasons similar to those as set forth above with respect to claim 38. Claims 60-63 depend from claim 59 and are allowable for at least the reasons set forth above as well as for their additional features. Accordingly, Applicant submits that each of newly added claims 58-64 are allowable.

Additionally, new claims 65 and 66 are previously pending claims 53 and 56 rewritten in independent form. Thus, all of the features in new claims 65 and 66 were previously considered by the Examiner as claims 53 and 56, respectively. Claims 53 and 56 were rejected in the Office Action under 35 U.S.C. § 103(a) based only on White. These rejections can be overcome by showing that White is disqualified as prior art under 35 U.S.C. § 103(a). According to 35 U.S.C. § 103(c)(1):

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under [35 U.S.C. § 103] where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

As set forth in the Statement of Common Ownership below, both White and the pending application were, at the time the claimed inventions were made, owned by or subject to an obligation of assignment to Scimed Life Systems Inc. Therefore, White does not qualify as prior art to the pending application under 35 U.S.C. § 103(a).

Statement of Common Ownership

Under the provisions of M.P.E.P. §706.02(l)(2), Applicant's undersigned representative of record supplies the following statement to the effect that this application and White (U.S. Patent No. 6,872,211) were, at the time the invention of this application was made, owned by, or subject to an obligation of assignment to, Scimed Life Systems, Inc.

The pending application, U.S. Patent Application No. 10/720,598 filed November 24, 2003 in the name of Robert Reynolds, Kevin Richardson, and Mark Bowen, and U.S. Patent No. 6,872,211, filed January 24, 2002 in the name of Curtis White, Brad Elliott, and James Bates, were, at the time the invention of the pending application was made, owned by or subject to an obligation of assignment to Scimed Life Systems, Inc.

Conclusion

Applicant respectfully requests the reconsideration of the rejections set forth in the Office Action in light of the proposed amendments to claims 38, 48, and 51, cancellation of claims 42, 46, and 52-56, addition of claims 58-66, and the remarks set forth above. Applicant requests entry of this Reply under 37 C.F.R. § 1.116, which places all of the pending claims in condition for allowance.

Applicant submits that the proposed amendments do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner. Therefore, this Reply should allow for immediate action by the Examiner.

Should the Examiner dispute the patentability of the pending claims, Applicant respectfully requests that this Reply under 37 C.F.R. § 1.116 be entered by the Examiner, placing the claims in better form for appeal.

In view of the foregoing remarks, Applicant submits that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art cited against this application. Applicant therefore requests the entry of this Reply, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

The Office Action contains characterizations of the claims and the related art, with which Applicant does not necessarily agree. Unless expressly noted otherwise, Applicant declines to subscribe to any statement or characterization in the Office Action.

If the Examiner believes a telephone conversation might advance prosecution, the Examiner is invited to call Applicant's undersigned representative at 202-408-4397.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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By: 
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